REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action transmitted February 3, 2009 ("*Office Action*"). Claims 1-25 are pending in the Application and stand rejected. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case. Applicant currently amends Claims 1, 10, 19 and 28. These amendments are fully supported by the specification as originally filed.

I. **Rejections under 35 U.S.C. § 112**

   A. *The Office Action maintains its rejection of Claims 1-25 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.*

With respect to Claims 1, 9, 17, and 25, the *Office Action* maintains its assertion that Applicant has not defined any means to determine a provider as satisfactory or to rank those that are satisfactory. *Office Action*, p. 3. The claim language itself, however, clearly describes "determin[ing] whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and rank[ing] each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers."

In addition, with regard to determining whether the service provider is satisfactory, the specification recites that, by "[u]sing elements such as service registry 24, organization agent 22 can discover one or more potential services 18 for fulfilling a specified business function." P. 10. Moreover, "[o]rganization agent 22 queries the identified services regarding specific service descriptions at step 118. This permits organization agent 22 to further refine the list of potential services 18 for fulfilling the business function requirements." P. 19, ll. 22-24.

With regard to ranking each of the satisfactory service providers, the specification recites that "organization agent 22 ranks the matching services 18 according to appropriate criteria at step 124. For example, in the purchasing context, organization agent 22 may arrange various product bids based upon cost, delivery time, and other suitable criteria." P. 20, ll. 2-5. Thus, contrary to the *Office Action's* assertion, Applicant has provided means to determine a provider as 'satisfactory' and means to rank those that are satisfactory.

With respect to Claim 9, the *Office Action* also maintains its assertion that Applicant's disclosure does not disclose how an "agent" establishes a database. *Office Action*, p. 3. In

support of maintaining its assertion, the *Office Action* explains that the portion of the specification previously cited by Applicants does not even mention a database. *Office Action,* p. 4. Applicant again respectfully submits that the claim terms should take their plain, ordinary meaning, given their context in the claim language and the descriptions in the specification, as would be attributed by one of ordinary skill in the art. In context, Claim 9 recites that "an organization agent . . . establish[es] an organizational database <u>maintaining</u> at least one business function description comprising a business function indicator and a plurality of business function requirements." (Emphasis added). As example support for this type of function, the specification recites: "organization agent 22 and/or organization 14 <u>maintain</u> a variety of information, such as plans, rule systems, and organization descriptors." P. 8, ll. 18-19. Thus, contrary to the *Office Action's* assertion, Applicant has disclosed how an "agent" establishes a database, given its context in the claim language and the descriptions in the specification. The specification need not recite the exact term "database" to enable the claims under § 112, first paragraph.

Accordingly, Claims 1, 9, 17, and 25 comply with the enablement requirement, and Applicant respectfully requests the Examiner to withdraw the rejection and allow these claims.

> B.   *The Office Action also maintains its rejection of Claims 9-16 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.*

With respect to Claim 9's "organization agent," the *Office Action* maintains that the system components or structure is not claimed such that one understands the structure required to carry out these steps. *Office Action,* p. 4. Applicant again respectfully submits, however, that Claims 9-16 are definite without amendment because the meaning of these claims would be clear to one of ordinary skill in the art. *See* M.P.E.P. § 2173.02. Breadth of a claim is not to be equated with indefiniteness. *In re Miller,* 441 F.2d 689, 169 USPQ 597 (CCPA 1971). "If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." MPEP §2173.04. Accordingly, a term is not indefinite merely because it lacks structural elements; rather, terms may take the plain and ordinary meanings that are consistent with the specification.

In Claim 9, the plain and ordinary meaning of the phrase "organization agent" would be clear to one of ordinary skill in the art in light of the specification. For example, Applicant's specification recites: "Within organization 14, organization agent 22 handles this dynamic discovery and interaction by interfacing with service providers 12 and other elements of system 10. To perform organization management, organization agent 22 and/or organization 14 maintain a variety of information, such as plans, rule systems, and organization descriptors." P. 8. The specification also recites: "Interface 42 provides a link between agent 40 and other entities within system 10. Depending upon the particular types of communications and configurations within system 10, interface 42 may include any suitable combination of hardware and/or logic for interacting with other components." P. 15. Moreover, the claim language itself recites "an organization agent coupled to the service providers and the service registry using a communication network."

Because the meaning of the phrase "organization agent" would be clear to one of ordinary skill in the art in light of the specification, Applicant submits that Claims 9-16 are, in fact, definite and comply with 35 U.S.C. § 112, second paragraph. Applicant therefore respectfully requests the Examiner to withdraw the rejection and allow these claims. Attorneys for Applicant stand ready to conduct a telephone conference if the Examiner would like to further discuss these issues.

II.   Rejections under 35 U.S.C. § 101

The Examiner rejects Claims 1-16 under 35 U.S.C. § 101 because they are directed to non-statutory subject matter. Under the rule recently enunciated in *In re Bilski*, an invention is patent-eligible if it (1) is tied to a particular machine or apparatus; or (2) transforms a particular article into a different state or thing. *In re Bilski*, No. 2007-1130, slip op. (Fed. Cir. October 30, 2008).

With respect to Claims 1-8, the *Office Action* argues that the claimed process does not satisfy the transformation test. *Office Action*, p. 6. Specifically, the *Office Action* states that Claim 1 does not recite any use of a template. *Id.* Applicant respectfully disagrees. Applicant's specification recites, "plans 48 may provide templates or other suitable constructs for identifying and aggregating a group of other services 18 into a single offering." P. 13, ll. 1-2. Also, "plans 48 may include one or more business function descriptions." P. 12, ll. 11-12. In addition, "these business function descriptions enable agent 40 to discover, interact

with, and judge the responses received from services 18." P. 12, ll. 15-17. Further, "system 10 contemplates agents 40 having any suitable combination and arrangement of elements to support template-based composition of remote services." P. 15, ll. 28-30. Moreover, "[i]nterface 42 provides a link between agent 40 and other entities within system 10," and "interface 42 may include any suitable combination of hardware and/or logic for interacting with other components." *Specification*, p. 15, ll. 4-7. Applicant thus respectfully submits that Applicant's process is patent-eligible because it transforms the template from a first state to a second state. Furthermore, Applicant's process is tied to hardware and/or logic.

With respect to Claims 9-16, the *Office Action* argues that the claimed service providers are not patent-eligible because they encompass human beings. According to Applicant's specification, however, the meaning of the phrase "service providers" does not encompass human beings. The Specification provides: "Each service provider 12 represents any suitable collection of components capable of offering access to services through defined interfaces. Service providers 12 offer machine readable interfaces that enable structured queries to access and interact with information regarding services 18." *Specification*, p. 6, ll. 14-17. In addition, "services 18 may include . . . functional aspects, such as service features 52 and feature interfaces 56," and "system 10 contemplates services 18 including any suitable combination of hardware and/or logic and the functionalities of services 18 being incorporated in and/or provided by any suitable network accessible equipment." *Specification*, p. 17, ll. 18-25. Thus the phrase "service providers" cannot be interpreted to encompass human beings. Even if the meaning of the phrase "service providers" were interpreted to encompass human beings, the claim language itself refutes any such interpretation, reciting "service providers each having a network address, a plurality of features providing access to a service, and a plurality of service descriptors describing the service." Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 9-16 under § 101 and allow these claims.

III.   Rejections under 35 U.S.C. § 103

A.   **Claims 1-7, 9-15, 17-23, and 25 are patentable over *Das* and *Vashistha*.**

The Examiner rejects Claims 1-7, 9-15, 17-23, and 25 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2003/0023499 to Das, et al. ("*Das*") in view of U.S. Patent Publication No. 2001/0051913 to Vashistha, et al. ("*Vashistha*"). Applicant

respectfully traverses this rejection and submits that *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest the combination of limitations recited in the claims.

Consider Applicant's independent Claim 1, as amended, which recites:

> A method for automated management of business services comprising:
> establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements;
> accessing a service registry using the business function indicator to identify a network address for each of a plurality of service providers each having a service indicator matching the business function indicator;
> for each of the identified service providers:
> communicating with the service provider to determine feature interfaces for interacting with the service provider;
> accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider;
> determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and
> if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider;
> ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors from each of the satisfactory service providers; and
> accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service.

Among other aspects, *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest (1) "accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; . . . if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider; . . . and accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service;" and (2) "ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors from each of the satisfactory service providers," as Claim 1 requires.

> *i.*   ***Das and Vashistha fail to teach or suggest accessing a first one of the feature interfaces . . . using a second one of the feature interfaces . . . and accessing a third feature interface of the highest ranking one of***

the satisfactory service providers to authorize performance of the service.

Claim 1, as amended, requires "accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; . . . if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider; . . . and accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service." As teaching the claimed service providers, the *Office Action* points to *Das's* product vendors of ¶ 66. The *Office Action* then assumes that the claimed "feature interfaces for interacting with the service provider" must be determined because *Das* teaches that services are identified in ¶ 50. *Office Action,* p. 7. With regard to identifying services, *Das,* at ¶ 50, recites that "[t]he products or services (hereafter only referred to as products for readability) identified in the strategic purchasing policy rules are associated with values that are used by the present invention to establish parameters for negotiating the purchase of these products from sellers." ¶ 66. Thus the automated purchasing system of *Das* merely uses the rules set by the vendors to guide purchasing decision making. *See Das* at ¶ 47 (describing that the strategic purchasing policies of human beings associated with the vendors are "reduced to sets of rules"). The cited portion of *Das,* however, fail to describe the claimed "feature interfaces for interacting with the service provider," such as the first feature interface, the second feature interface, and the third feature interface, as recited by Claim 1.

As just one example, Claim 1, as amended, requires "accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider." As teaching these aspects, the *Office Action* points to *Das,* paragraphs 47, 48, 50, 52, and 68. In the cited portion, *Das* provides that "[e]ach time a counteroffer is received, the purchasing system determines whether it is acceptable, using its internal rules and parameters." ¶ 68. *Das* also describes that "the functions of the present invention do not require actual negotiation." ¶ 45. In contrast, the *Office Action* argues that "parameters are used to negotiate the purchase from sellers, therefore, negotiation involves determining descriptors provided by the provider." *Office Action,* p. 7. The *Office Action* therefore merely concludes that *Das's* negotiation involves descriptors and then equates those fictional descriptors to the claimed service descriptors.

The *Office Action*, however, fails to establish that *Das's* purchasing system ever "access[es] a first one of the feature interfaces of the service provider" or "determine[s] a plurality of service descriptors describing a service," as Claim 1 recites. If the Office Action here is intending to imply that the descriptors are inherent, a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art must be provided. M.P.E.P. § 2112. Accordingly, the cited portion of *Das* fails to teach or suggest the step of "accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider," as Claim 1 recites.

For at least these reasons, *Das* fails to teach or suggest "accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; . . . if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider; . . . and accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service." *Vashistha* fails to remedy the deficiencies of *Das*.

> **ii.** **Das and Vashistha fail to teach or suggest ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors from each of the satisfactory service providers.**

Claim 1, as amended, requires "ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors from each of the satisfactory service providers." As teaching these aspects, the *Office Action* relies on *Vashistha*, paragraph 66. The *Office Action* argues that "Vashistha, however, discloses ranking bids (P[0066]) following a discussion and bidding module which provides a mechanism for facilitating the collaboration between buyers and providers to obtain an improved understanding of the RFP requirements." *Office Action*, p. 9 (emphasis added). The cited portion of *Vashistha*, however, fails to teach "ranking . . . based on the variable service descriptors" because *Vashistha* does not teach "negotiat[ing] a plurality of variable service descriptors," as Claim 1 recites. Rather, the cited portion of *Vashistha* merely describes "collaboration with buyers for better communication and understanding of the RFP requirements," which are the buyer's Requests For Proposal for an IT project or service, not

the provider's service descriptors describing the service (emphasis added). ¶¶ 37 and 64. Accordingly, the cited portion of *Vashistha* fails to teach or suggest "ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors from each of the satisfactory service providers," as Claim 1 recites. *Das* fails to remedy the deficiencies of *Vashistha*, as the *Office Action* appears to agree. *See Office Action*, p. 9 ("Das does not disclose ranking based on the negotiations.").

Independent Claims 9 and 17 include limitations that, for substantially similar reasons, are not taught by *Das* and *Vashistha*. Because *Das* and *Vashistha* do not teach or suggest every element of independent Claims 1, 9, and 17, Applicant respectfully requests reconsideration and allowance of Claims 1, 9, and 17 and their respective dependent claims.

B.   Claims 8, 16, and 24 are patentable over the *Das, Vashistha,* and *Chun*.

The Examiner rejects Claims 8, 16, and 24 under 35 U.S.C. §103(a) as unpatentable over *Das* in view of *Vashistha* in further view of U.S. Publication No. 2002/0184527 to Chun et al ("*Chun*"). As described above, Applicant has shown that *Das* and *Vashistha* fail to disclose all limitations of independent Claims 1, 9, and 17. Accordingly, *Das* and *Vashistha* fail to teach or suggest all limitations of Claims 8, 16, and 24 because these dependent claims incorporate the limitations of their respective independent claims. *Chun* fails to remedy the deficiencies of *Das* and *Vashistha*.

Thus, *Das, Vashistha,* and *Chun*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 8, 16, and 24. Because the references fail to teach all limitations of the claims, Applicant respectfully requests reconsideration and allowance of Claims 8, 16, and 24.
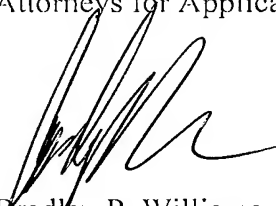
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of this Application.

If the Examiner feels prosecution of the present Application may be advanced by a telephone conference, Applicant invites the Examiner to contact the undersigned attorney at (214) 953-6584.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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